UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,311	06/19/2001	Steven B. Adler	AUS920010589US1	6894

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EXAMINER
BARRON JR, GILBERTO

ART UNIT	PAPER NUMBER
2132	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/884,311	ADLER ET AL.
	Examiner	Art Unit	
	Gilberto Barron Jr.	2132	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 November 2007</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,12-17,19,21 and 22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,12-17, 19 and 21-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Response to Amendment

Applicant's arguments have been fully considered but are not persuasive. Applicant argues "It should be noted that claim 1 of the present application recites three specific active entities: (1) a first data user that requests personally identifiable information from (2) a data subject, and (3) a second data user that requests the personally identifiable information for the data subject (2) from the first data user (1). The rules define if and how the personally identifiable information (about the data subject (2)) may be provided, by the first data user (1), to the second data user (3)."

However, the claims in fact only specify that "said rules define if and how said personally defined information may be provided, by said first data user, to said second data user." This is the case for any user requesting personally identifiable information form any user which is disclosed in the Benantar reference. The claims do not link the original data set first requested by the first user to the transmission of that data set to the third user. All references to personally identifiable information are generic and, under a broad but reasonable interpretation the data set requested by the third entity is any data and not the one argued by Applicant.

1.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Objections – 37 CFR 1.75

Claims 15, 16, and 22 are objected to 37 CFR 1.75(d)1 because the claimed "computer

recordable" term is not defined in the specification and therefore the claim term lacks

antecedent basis in the specification

No new matter should be introduced into the specification to address this issue.

Applicant should clearly indicate where support for the term is found in the original

disclosure.

Claim Rejections - 35 USC § 102

Claims 1, 2, 12, 13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated

by Benantar et al. (U.S. Pat. No. 5,787,427).

With respect to claims 1, 12, and 15: The Benantar reference describes an

object-oriented system that provides security for objects by grouping objects that share

common control access policies.

A method, in a data processing system, for handling personally identifiable information,
said method comprising:
providing, in a computer, a first set of object classes representing active entities in an
information-handling process, wherein a limited number of privacy-related actions
represent operations performed on data and wherein each of the active entities is a
human being or legal entity [see Figure 4, Object Group I];
providing, in said computer, a second set of object classes representing data and rules
in said information-handling process, wherein at least one object class has said rules
associated with said data, and wherein said data represents said personally identifiable
information [see Figure 4, Object Group 2]; and
processing transactions, in the data processing system, involving said personally
identifiable information, using said computer and said first and second set of object
classes, so as to enforce a privacy policy, associated with the personally identifiable
information and defined by said rules, against one or more active entities represented
by said first set of object classes [see column 3, lines 1-20],

wherein each of the one or more active entities represented by said first set of object classes is a human being or legal entity [see column 3, lines 22-43] , wherein:

a first active entity represented by a first object class in said first set of object classes is a first data user that requests said personally identifiable information from a data subject that is a second active entity represented by a second object class in said first set of object classes,

said data subject is an active entity that is personally identifiable by said personally identifiable information;

a third active entity represented by a third object class in said first set of object classes is a second data user that requests personally identifiable information from said first data user, and

said rules define if and how said personally identifiable information may be provided, by said first data user, to said second data user [see column 5, lines 35 –50].

Further reference is made to column 6, lines 48-53.

Benantar discloses that the objects may represent various parties, see Figures 1 and 5, to address claims 2, 13, and 16.

Claim Rejections - 35 USC § 103

Claims 3, 14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Benantar et al. in view of Tolopka et al. (U.S. Pat. No. 6,044,349).

The Benantar reference does not disclose an object class representing a filled

paper form.

The secondary reference Tolopka teaches a storage medium for storing personal

information that is subject to access control for apportion the data among authorized

entities. Figure 2 shows various types of information and options for authorizing access

to different groups. The information may represent a paper filled form, see column 6,

lines 36-52.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the objects in Benantar represent paper filled forms as taught in Tolopka as a convenient manner of obtaining personal information and populating as an object, see column 6, lines 36-52.

Claims 19, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benantar et al. (U.S. Pat. No. 5,787,427) in view of Gifford et al (U.S. Pat. No. 5,614,927).

The Benantar reference does not disclose transforming the personal information into a depersonalized format.

The Gifford reference teaches protection of confidential information in a database. Column 8, lines 1-8, teaches a method where the correlation between public attributes and private attributes are reduced by camouflaging or outright removing some data to depersonalize the identifiable information based on rules.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data in the object groups in Benantar be depersonalized, i.e. camouflaged or removed, as taught tin Gifford in order to protect confidential information from being inferred from a database, see column 4, lines 17-68.

2.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
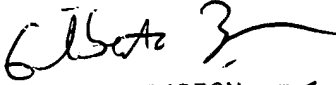
A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Gilberto Barron Jr. whose telephone number is 571-272-

3799. This Supervisor can normally be reached on Mondays thru Thursdays from 8 AM

to 4:30 PM. This Supervisor can also be reached on alternate Fridays.

The fax phone number for the organization where this application or proceeding

is assigned is 571-273-8300.

Gilberto Barron Jr.
SPE
Art Unit 2132

GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100